

REMARKS

This amendment is in response to the Office Action dated December 13, 2004. Claims 1-15 are pending.

The Examiner has required restriction to one of the following groups under 35 U.S.C. § 121:

Group I: Claims 1-2 and 8, drawn to the chemical compound;

Group II: Claims 3-7, drawn to a process of preparing a compound; and

Group III: Claims 9-15, drawn to a method of treating obesity.

Applicants hereby provisionally elect examination of Group I (claims 1, 2 and 8) drawn to the compound N-aryloxypropanolyl-N'-phenethyl urea, with traverse.

Although Applicants are making the above election to be fully responsive to the Restriction Requirement, Applicants respectfully traverse the Requirement and reserve the right to petition under 37 C.F.R. §1.144. Applicants request reconsideration and withdrawal of the Restriction Requirement to allow prosecution of at least Groups I and II in the present application, for the reasons provided below.

Traversal of Restriction Requirement

The Examiner alleges that Group I and Group II are patently distinct in that Group I comprises a product that can be made by other processes, and that the process in Group II can be used to make other products. Likewise, the Examiner contends that Group I and Group III are related as product and process of use, where the process can be used with materially different products, and the product can be used in a materially different process of using the product. Therefore, the Examiner maintains that the inventions of Groups I, II and III are separate and distinct inventions as a reference anticipating one of the references would not necessarily render another obvious.

Under 35 U.S.C. §121, "two or more independent and distinct inventions... in one application may... be restricted to one of the inventions". However, even with patentably distinct inventions, restriction is not required unless one group has a separate classification, separate status in the art, or different field of search. According to Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803 (emphasis added).

Applicants respectfully submit that Groups I and II designated by the Examiner fail to define compositions and methods that warrant separate examination and search. Claims 1-8 represent subject matter that merits examination in a single application. In particular, the subject matter of Groups I and II have been classified into the same class (Class 564), and a thorough search of the subject matter of Group II would necessarily include a search of the subject matter of Group I as the subject matter of Group II is the manufacture of the compositions of Group I. The search and examination of Group I and II is necessarily co-extensive and would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. Accordingly, applicants respectfully request that the Examiner modify the Requirement for Restriction and at minimum examine claims 1-8 (Groups I and II) together.

Early and favorable consideration of this response and the claims is earnestly solicited. If there are any other issues remaining which the Examiner believes could be resolved through

either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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